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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,588	04/09/2004	William K. Leonard	55476US041	1883
32692	7590	06/23/2005	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			EDWARDS, LAURA ESTELLE	
			ART UNIT	PAPER NUMBER
			1734	

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/821,588

Applicant(s)

LEONARD ET AL.

Examiner

Laura Edwards

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 5-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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***Election/Restrictions***

This application contains claims 5-18 are drawn to a non-elected invention. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action.

***Claim Rejections - 35 USC § 112***

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 10-12, Applicants recite "whose lengths along the substrate, ... are not all the same" and the use of the term "whose" lends ambiguity as to what is being referred to even when reading the claim in light of the specification. Clarification is necessary.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall (GB1278099).

Hall teaches an apparatus for improving uniformity of a liquid coating on a substrate comprising the combination of at least two or more pick-and-place devices (3; col. 1, lines 41-46) that rotationally move or translate in the direction of travel of the substrate, the pick and place devices periodically contacting the coating and re-contact said coating at different positions, said positions including the direction of travel of the substrate (see Fig. 3) or the axial direction (see Fig. 4) wherein the pick-and-place devices are out of phase with one another (see claim 5) constituting non-periodically related devices. Even though Hall does not explicitly teach <sup>different</sup> lengths or distances along which the pick-and-devices contact and recontact the coating on the substrate, one of ordinary skill in the art would expect that the contacting distances or lengths of the devices would be different because the devices are translated or moved out of phase with one another such that the devices are not periodically related along the direction of travel of the substrate.

With respect to claims 3 and 4, Hall recognizes two or even five pick-and-place devices being (see col. 1, lines 41-46). In addition, all the pick-and-place devices can be moved out of phase with one another such that the devices are not periodically related as evidenced by col. 1, lines 80-89.

***Response to Arguments***

Applicants' arguments filed 4/7/05 have been fully considered but they are not persuasive.

Applicants contend that the Hall arrangement, including rollers (3) all the same size, mounted together, geared together, and spinning at the same speed, would by itself merely repropagate and not reduce [coating] defects as set forth by Applicants' written description at page 10, lines 9-17. This argument is not deemed persuasive because the Hall arrangement is not as simple as Applicants have described above. Hall provides an apparatus including pick-and-place devices substantially as Applicants claim with the exception of disclosure of pick-and-place devices contacting lengths (i.e., distances) being disclosed. However, one skilled in the art would recognize that contacting lengths or distances would be effected by the Hall pick-and-place devices when the devices are translated, out of sync or out of phase, in the travel direction of the substrate. The Hall arrangement would thereby reduce coating defects.

Applicants contend that Hall does not show vibrating the two or more rollers in the direction of travel of the substrate to improve down-web uniformity. This argument is not deemed persuasive because while Hall minimally illustrates in Fig. 3, vibrational movement of at least one pick-and-place device in the direction of travel of the substrate, Hall further recognizes that each of the pick-and-place devices can move in the direction of travel of the substrate as evidenced by claim 9. Therefore, one skilled in the art would recognize that Hall also provides for improved down-web uniformity.

### ***Conclusion***

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura Edwards whose telephone number is (571) 272-1227. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Laura Edwards  
Primary Examiner  
Art Unit 1734

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June 22, 2005